

REMARKS

Claims 1-19, 21-22, and 31-37 remain pending in the present application, including independent claims 1, 12-14, and 31. Claims 1-11, 14-19, 22, 31-35 and 37 are allowed. Applicant respectfully requests reconsideration and allowance of rejected claims 12, 13, 21 and 36 in view of the following remarks.

Independent claim 12, for instance, is directed to a surface-modified article. The article comprises an elastomeric matrix having an outside surface. A plurality of colloidal silica particles are adhered to at least a portion of the outside surface of the matrix without any separate binder material. The particles are partially embedded in said outside surface without extending through the thickness of the matrix.

In the Office Action, claims 12, 13, 21 and 36 were rejected under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 3,637,416 to Misch, et al. in view of the Abstract of JP 0216527 (hereinafter "JP '527"). Misch, et al. is directed to the interposition of a thin, continuous polymeric bonding film or layer composed of one or more ambifunctional silanes between the surfaces of a plastic or elastomeric material substrate and a deposit or coating of silica or silica gel. Col. 4, ll. 21-25. A long, representative list of ambifunctional silanes is disclosed in Col. 5, ll. 39-75.

In fact, the lone figure disclosed in Misch, et al. clearly shows a middle layer, referred to as a "Bonding Layer or Film," between the plastic or elastomer and the silica or silica gel.

As such, Applicant respectfully submits that Misch, et al. teaches away from independent claims 12 and 13. Both independent claims 12 and 13 require that the surface-modified article comprise a plurality of colloidal silica particles **without any**

separate binder material. There is no suggestion in Misch, et al. to remove the bonding layer or film from the article. In fact, Applicant believes that the bonding layer or film is an essential part of the article disclosed in Misch, et al. and that removing the bonding layer or film would destroy the function of that article.

Applicant emphasizes that the teachings of the references must be viewed in their entirety, i.e., as a whole, to sustain a *prima facie* case of obviousness under 35 U.S.C. §103(a). Further, the appropriate test under 35 U.S.C. §103(a) is not whether the differences between the prior art and the claims are obvious, but instead whether the claimed invention as a whole would have been obvious. That is, the differences between a particular claim and the cited references cannot be viewed in a vacuum. In this case, Applicant respectfully submits that, when properly viewed as a whole, there is simply no motivation to combine the references in the manner suggested in an attempt to render obvious the present claims. Thus, for at least the reasons set forth above, Applicant respectfully submits that independent claims 12 and 13 patentably define over the above-cited references, taken alone or in any proper combination.

Thus, Applicant believes that modification of Misch, et al. as suggested by the Office Action is improper. As such, Applicant respectfully submits that a *prima facie* case of obviousness has not been established and that independent claims 12 and 13 are patentable over Misch, et al. in view of JP '527.

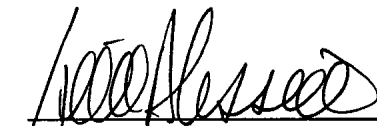
Thus, Applicant respectfully submits that the present claims patentably define over all of the prior art of record. It is believed that the present application is in complete condition for allowance and favorable action, therefore, is respectfully

requested. Examiner Nolan is invited and encouraged to telephone the undersigned, however, should any issues remain after consideration of this response.

Please charge any additional fees required by this Amendment to Deposit Account No. 04-1403.

Respectfully requested,

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